

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number 1080 001 301 0202
	Application Number 10/092,674	Filed March 7, 2002
	First Named Inventor Stephen C. Larson	
	Art Unit 2176	Examiner C. Nguyen
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p>		
<p>I am the</p> <div style="display: flex; justify-content: space-between;"> <div style="width: 60%;"> <p><input type="checkbox"/> applicant/inventor. —</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>34,545</u>.</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34.</p> <p><input type="checkbox"/> Registration number if acting under 37 CFR 1.34</p> </div> <div style="width: 35%;"> <p>Signature <u>/Duane C. Basch, Esq. Reg. No. 34,545/</u></p> <p>Typed name <u>Duane C. Basch</u></p> <p>Telephone number <u>585-899-3970</u></p> <p>Date <u>02/04/08</u></p> </div> </div> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>		
<p>* Total of forms are submitted.</p>		

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

Remarks in Support of Pre-Appeal Request for Review

(I) Claims 1-8 remain rejected under 35 USC §103(a) as being unpatentable over Brown et al. US 6,931,591 (Brown), Hu et al. US 6,275,309 (Hu) and further in view of Angiulo et al. US 6,275,829 (Angiulo). (II) Claims 9-12 and 21-23 are also rejected under 35 USC §103(a) as being unpatentable over Angiulo in view of Hu.

(I) Claims 1-8 rejected under 35 USC §103(a)

Claims 1-8 were rejected under 35 USC §103(a) as being unpatentable over Brown, Hu and further in view of Angiulo. Independent claim 1 recites an on-line newspaper publishing system including, among other elements, at least one layout template defining at least a region on a web page for the display of a preview image of a display advertisement, with a composition computer producing image files, the image files including images of full-size display advertisements and corresponding reduced-size, anti-aliased preview images (both stored in the image database), and also producing browser-readable code representing a web page, the web page comprising at least one link to the full-size display advertisement image file stored in the database, wherein the link is provided by a corresponding reduced-size, anti-aliased preview image.

To establish *prima facie* obviousness, there must be some suggestion or motivation to modify the reference or to combine reference teachings. Furthermore, the prior art reference (or references when combined) must teach or suggest **all** the claim limitations. Relative to the latter requirement, MPEP 2143.03 requires that all claim limitations must be taught or suggested by the prior art to establish *prima facie* obviousness of a claimed invention. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974; emphasis added). Furthermore, **"[a]ll words in a claim must be considered** in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970; emphasis added).

Although acknowledging that Brown fails to teach article content of a paper-based publication, the rejection urges that Brown teaches at least one layout template, the template defining at least a region on a web page for the display of a preview image of a display advertisement at col. 5. Applicant respectfully disagrees and notes that the cited portion of Brown is directed to templates for the creation of advertisements, not for the layout of article content and display advertisements. Thus, there is no teaching of the noted limitations of claim 1. The Examiner has also acknowledged that Brown does not disclose article content as the term has been employed in claim 1. Moreover, the beginning of the cited paragraph (e.g., Brown, col. 4, lines 63-67) make it clear that

instead of collating print materials, system 10 is utilized to access materials by which weekly advertisements are prepared. At col. 5, lines 39-41 Brown states, “[t]he final high-resolution file is downloaded only when the advertisement has been finalized and accepted by the user.” (emphasis added)

Conversely, claim 1 recites image files including images of full-size display advertisements and corresponding reduced-size, anti-aliased preview images, where the template is used to lay out the page with the preview images. As Brown is directed to the composition of advertisements, it cannot have full and reduced size images of the display advertisements available. Nor does Brown (or Hu, or Angiulo) disclose the use of anti-aliased preview images.

As noted above, the rejection acknowledges that Brown does not teach article content of a paper based publication to be converted for publication in a digital edition as required by amended claim 1. However, Hu is urged to teach such a limitation. Hu is directed to lightweight mobile scanners, and states at col. 1, lines 18-21 that “flatbed scanners ... convert scanning objects, including pictures and papers, to images that can be used, for example, for building World Wide Web pages and optical character recognition.” Applicant respectfully maintains that such a statement does not teach the recited limitation of “article content of a paper-based publication to be converted for publication in a digital edition hosted on the networked host server” as set forth in claim 1. The Examiner’s response to Applicant’s argument similarly lacks any reference to a teaching of the recited limitations, and merely refers to previously referenced column 1 of Hu. Thus *prima facie* obvious has not been established.

Applicant respectfully urges that Hu is not properly combined with Brown, particularly where Brown teaches the on-line composition of advertising materials for printing, and Hu teaches the digitization of images and documents. In response to Applicant’s questioning of the desirability to convert the content of a paper-based publication for publication in a digital edition, the Examiner sets forth an argument in support of the obvious to combine rationale that relies upon conclusions that also do not appear to be supported by Brown, Hu or other knowledge of one of skill in the art. What basis is there, other than the instant application, to show that the combination would have resulted in efficient access for readers, or that the combination would yield predictable results? Applicant continues to urge that such a basis is hindsight reconstruction as that suggestion is found in the instant application (see page 2 of Specification for the instant application). Furthermore, because Brown is directed to preparing print advertisement and Hu is directed to digitizing printed documents, the teachings would seem inherently

contrary to one another such that one would not have been motivated to make the proposed combination.

Lastly, Angiulo is urged as an addition to the combination for the teaching of original and thumbnail images. While this may be the case, Angiulo nonetheless is urged as failing to teach anti-aliased preview images or more particularly the recited limitation of “image files including images of full-size display advertisements and corresponding reduced-size, anti-aliased preview images, said full-size display advertisements and corresponding reduced-size, anti-aliased preview images being stored in said image database; and ... at least one link to the full-size display advertisement image file that is also stored in the database, wherein the link is provided by a corresponding reduced-size, anti-aliased preview image.” (emphasis added) At best, Angiulo fails to teach all of the limitations it has been urged to, and the Examiner’s response fails to address where, for example, the anti-aliased requirement is taught by any of the cited references. Thus, the arguable combination with the teachings of Angiulo does not overcome the deficiencies of Brown or Hu as noted above. Accordingly, Applicant respectfully traverses the rejection and urges that claim 1, and all claims dependent therefrom, including claims 2-8, are in condition for allowance.

With respect to dependent claims 2-8, for the sake of brevity Applicant will not address the reasons supporting patentability for these individual dependent claims, as these claims depend directly or indirectly from independent claim 1. Should it be necessary, the patentability of these dependent claims will be specifically set forth in Applicant’s Appeal Brief.

(II) Claims 9-12 and 21-23 rejected under 35 USC §103(a)

As previously noted, in order to establish *prima facie* obviousness, all limitations of the claimed invention must be set forth in the references relied upon. Independent claim 9 specifically recites “...creating a reduced-size preview image of the advertiser digital copy using a digital computer to perform an image size reduction operation that includes an anti-aliasing filter, wherein at least one dimension of the reduced-size preview image is determined in accordance with a predetermined size...” Applicant respectfully urges that the rejection fails to set forth where the underlined limitations have been taught by Angiulo, or Hu. As previously set forth, Applicant’s search of the text of Angiulo failed to identify the use of anti-aliasing or advertiser copy, for example. As a result such limitations are not taught by Angiulo, and *prima facie* obviousness has not been established. In the response to Applicant’s arguments, the Examiner clearly fails to set

forth any teaching of an anti-aliasing filter. Thus, the rejection is incomplete and withdrawal is respectfully requested.

As discussed above, Hu is urged to provide the teaching of an optical scanner, yet does not appear to teach the specific limitations of claim 9 that are emphasized above. Nor has the Examiner set forth a basis for the alleged combination that is supported by anything other than Applicant's specification. Hence, Applicant respectfully maintains that the rejection is improper as it fails to teach all claim limitations, and further fails to provide proper basis for the proposed combination. Accordingly, the rejection of claim 9 is respectfully traversed.

Independent claim 22 is apparently rejected on the same basis as claim 9, however no specific discussion is found in the Final Office Action for independent claim 22 even though this was previously noted. Thus the rejection is incomplete on its face. Applicant respectfully urges the arguments set forth above to the extent they are consistent with the limitations in claim 22. Furthermore, the rejection fails to set forth where the specific limitations of claim 22 are taught by either Angiulo or Hu. For example, as similarly noted relative to claim 1, none of the cited references teaches the limitation of claim 22 for "storing the reduced-size preview image in the database" nor has such a limitation been set forth in the rejection. For this reason (failure to set forth where all recited limitations are found), *prima facie* obviousness has not been established and the rejection of independent claim 22 is respectfully traversed.

With respect to claims dependent from claims 9, 21 and 22, for the sake of brevity Applicant has not addressed these claims but reserves the right to address the patentability of these dependent claims separately in an Appeal Brief should that be necessary.

(III) Conclusion

Applicant respectfully urges that the Final Office Action, and the Examiner's "Response to Arguments," fails to acknowledge and adequately address the amendments previously made to the independent claims, or the previously-noted failures of the "rejections." The rejections continue to fail to set forth teachings for all elements recited in the claims. In view of the foregoing remarks and amendments previously made of record, the panel is urged to reconsider the claims set forth, the noted failures of the various rejections to establish *prima facie* obviousness, and to withdraw the finality of this Office Action and instruct the Examiner to proceed to indicate an allowance of the rejected claims.